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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,533	07/07/2003	Guy Lichtenwalter		10960809-5	8212
7590 05/11/2004				EXAMINER	
HEWLETT-PACKARD COMPANY				ZARNEKE, DAVID A	
Intellectual Pro P.O. Box 2724	pperty Administration 00		٢	ART UNIT	PAPER NUMBER
Fort Collins, C	CO 80527-2400			2827	

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	A						
	Application No.	Applicant(s)					
	10/615,533	LICHTENWALTER ET AL.					
Office Action Summary	Examiner	Art Unit					
	David A. Zarneke	2827					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION.  Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (8) MONTHS from the mailing date of this communication. If the pend of reply specified above is less than thirly (30) days, a reply if NO period for reply singuished above a loss than thirly (30) days, a reply if the property of the pro	(6(a). In no event, however, may a reply be time within the statutory minimum of thirty (30) days ill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONET	ely filed swill be considered timely. the mailing date of this communication. 0 (35 U.S.C. & 133)					
Status							
1) Responsive to communication(s) filed on							
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is							
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
4)⊠ Claim(s) <u>5-20</u> is/are pending in the application.							
4a) Of the above claim(s) is/are withdrawn from consideration.							
5) Claim(s) is/are allowed.							
6)⊠ Claim(s) <u>5-20</u> is/are rejected.							
7) Claim(s) is/are objected to.							
8) Claim(s) are subject to restriction and/or	election requirement.						
Application Papers							
9) The specification is objected to by the Examiner.							
10) ☐ The drawing(s) filed on <u>07 July 2003</u> is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a),							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
Priority under 35 U.S.C. § 119							
12) Acknowledgment is made of a claim for foreign a) I b) Some colone of:  1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the prior	have been received. have been received in Application	on No					
application from the International Bureau (PCT Rule 17.2(a)).							
* See the attached detailed Office action for a list of the certified copies not received.							
	ŧ						
Attachment(s)							
Notice of References Cited (PTO-892)	4) Interview Summary	(PTO-413)					
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date.							
Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)     Paper No(s)/Mail Date	<ol> <li>Notice of Informal Pa</li> <li>Other:</li> </ol>	atent Application (PTO-152)					
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## Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5-10 and 17-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Zaleckas, US Patent 4,091,529 (figures 1 & 4).

Regarding claims 7 and 8, the phrase "for registering the component lead with respect to the pad in a lateral dimension perpendicular to the arms portion of the solder mound" defines an intended use for the apparatus and is therefore given no patentable weight.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (Ex parte Masham, 2 USPQ2d 1647 (1987)).

With respect to claims 9 and 17, the phrase "for receiving an extremity of the component lead" defines an intended use for the apparatus and is therefore given no patentable weight.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

a prior art apparatus satisfying the claimed structural limitations (Ex parte Masham, 2 USPQ2d 1647 (1987)).

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As to claim 10, the phrase "for registering the component lead with respect to the pad in a lateral dimension perpendicular to the bridge portion of the solder mound" defines an intended use for the apparatus and is therefore given no patentable weight.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (Ex parte Masham, 2 USPQ2d 1647 (1987)).

## Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this tille, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaleckas, US Patent 4,091,529 (figures 1 & 4), as applied to claim 6 above.

Regarding claims 11-16 and 20, while Zaleckas fails to teach the exact dimensions of the pad and the mound, it would have been obvious to one ordinary skill in the art at the time of the invention to optimize these dimensions through routine experimentation (MPEP 2144.05).

## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Zameke whose telephone number is (571)-272-1937. The examiner can normally be reached on M-F 10 AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571)-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 10/615,533

Art Unit: 2827

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David A. Zarneke Primary Examiner

May 7, 2004